

Reissue Application No.: 10/655,549
Reply to Office Action of May 20, 2009

Art Unit: 3688

REMARKS / ARGUMENTS

Applicant thanks the Examiner for the careful examination of the present application. The following remarks and arguments are responsive to the Office Action mailed on May 20, 2009.

I. Status of the claims

Claims 1 - 17 and 99- 166 are pending in this application. Claim 1-17 and 99-166 stand rejected.

II. Requirement for Reissue Oath/Declaration under 35 U.S.C. § 251

The Examiner rejected the application under 35 U.S.C. § 251 for lacking a proper reissue oath or declaration. In response, it is noted, that to date, Mr. David W. Roth, one of the two named inventors on the instant application, could not be found after diligent effort. The Assignee will submit a petition under 37 C.F.R. § 1.47(a) for the non-signing inventor.

III. Rejection for provisional non-statutory obviousness type double patenting

The Examiner provisionally rejected claim 1-17 and 99-166 for non-statutory obviousness type double patenting, over claims 62-218 in co-pending U.S. Patent Application No. 09,216,206. In response, a Terminal Disclaimer is being submitted herewith, obviating the rejection.

IV. Rejection under 35 U.S.C. § 103(a) over Goldhaber et al.

The Examiner rejected claims 1, 4, 15, and 99-166 as being unpatentable over U.S. Patent No. 5,794,210 to *Goldhaber et al.* ("*Goldhaber*").

Goldhaber describes a system and method that compensates users for viewing advertisements on their computers. According to *Goldhaber's* invention, when a user logs on to his personal homepage, the user is shown a list of preselected advertisements that are targeted to the user's interest. *Goldhaber* Col. 7 lines 27-32. A virtual "price tag" is associated with each advertisement that indicates the amount the user will receive for viewing the advertisement. Each time the user selects an advertisement for further viewing, the user is compensated in the

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form of digital cash according to the "price tag" associated with the advertisement. The digital cash is credited to the user's account. *Goldhaber* Fig. 3, Col. 10, lines 39-66.

It is noted that according to *Goldhaber* the advertisements that are shown to a user are preselected for that user. In pertinence, *Goldhaber* states the following:

Upon logging on to her customized home page, Cynthia would be presented with a list of ads that she may elect to view. The ads would be preselected for her on the basis of a personal profile questionnaire that she has completed plus automatic tracking of her previous Internet usage. For example, today's list might contain ads for medium-price hotels in Mazatlan (where Cynthia is planning a vacation), a do-it-yourself telescope kit (a possibility for her son's upcoming birthday), San Francisco Forty-Niner football tickets (she's a fan), new nonfat organic dessert items (she's on a diet), and heavy equipment for earth moving (she is part-owner of a construction company). (emphasis added.)

Goldhaber at Col. 7, lines 27-35. Thus the system in *Goldhaber* present users with preselected advertisements together with associated price tags. The user then selects among the advertisements for further viewing, and is compensated according to the associated price tags.

The Examiner, in rejecting the claims, cites *Goldhaber* at col. 4 lines 47-63, where *Goldhaber* describes an auction mechanism through which advertisers can competitively bid for a viewer's attention. The cited passage in *Goldhaber* is reproduced as follows:

"Negative pricing" is one means by which advertisers could compete for available attention in the system provided in accordance with the present invention. In its simplest form, negative pricing is a "passive" competition: advertisers make fixed offers and viewers select among them. Another innovative idea is "attention bidding," a mechanism by which advertisers actively compete by bidding for a viewer's attention. These bids might be based, in part, on estimates of the viewer's interest and likelihood to buy--estimates derived from access to the viewer's electronic profiles detailing preferences and past consuming behavior. Bids might also be based on other bids, via an "auction" protocol by empowered bidding "agents." The bidding may be explicit or automatic. Viewers may elect to have advertisers bid for their attention or the system may offer bidding without the viewers' knowledge.

Goldhaber at Col. 4, lines 47-63. It is noted that the foregoing passage is the only description in *Goldhaber* of the auction mechanism. Other than this passage, *Goldhaber* does not elaborate on how the auction mechanism works. However, the passage is ambiguous, as certain aspects of the auction mechanism remain unclear. One possibility is that the auction mechanism in *Goldhaber*

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intends to provide advertiser's flexibility in pricing of their respective advertisements. Instead of associating every advertisement with the same fixed amount (e.g. \$1.00), the advertisers competitively bid between themselves, and the user is presented with different amounts associated with different advertisements based on competitive bidding (e.g. advertisement A = \$0.75; advertisement B = \$1.00, etc.) The system does not select among the different advertisements based on the bids. Rather, the user is shown all advertisements relevant to the user's interest, and the user then selects among the advertisements and the user is compensated in accordance with the bid amounts.

Another possibility is that the auction mechanism in *Goldhaber* allows only a single advertisement to be presented to a user, i.e. only the advertisement associated with the highest bid. Under this scenario, the system preselects the advertisement presented to the user in accordance with the auction results. Whenever the user logs onto his homepage, the user is presented with only the preselected advertisement that is associated with the winning bidder of the auction.

However, under each of the foregoing possibilities, *Goldhaber* does not provide for a real-time bidding and selecting mechanism, whereby the winning bid is selected by the system in real-time – that is at the time the web page is requested by a user, prior to the web page being transmitted to the user

In contrast, the invention of the present application as claimed provides for a real-time bidding system. The system selects among bidding advertisers in real-time based on a competitive bidding mechanism that occurs in real time – that is at the time a viewer requests a web page where a winning advertisement is displayed.

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CONCLUSION

In view of the foregoing arguments and remarks reconsideration of the outstanding rejections is respectfully requested. Should the Examiner consider an interview helpful in advancing the present application, the Examiner is respectfully requested to contact the undersigned at the number indicated below.

Dated: November 20, 2009

Respectfully submitted,

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